

REMARKS

Claims 1-27 were pending, claims 21-24 of which were withdrawn from consideration. By this Amendment, claims 21-24 are canceled, and new claims 28-31 are added. Reconsideration and allowance of claims 1-20 and 25-31 are earnestly solicited in view of the following remarks.

Claim 27 was objected to because "actuation of first switch" should read as "actuation of the first switch." Claim 27 is amended to correct this typographical error.

Claims 1-3 and 14 were rejected under 35 U.S.C. § 103 as being obvious over Raymond et al (U.S. Pat. No. 5,284,153) in view of Battiato et al (U.S. Pat. No. 5,925,022). Applicant traverses this rejection because there is no motivation or suggestion to make the proposed combination. Raymond et al. discloses a method "to locate nerves to assist in the administration of regional anesthesia" (col. 3, lines 23-24). Battiato et al. discloses a medical fluid injector for fluids such as "contrast media for a CT, Angiographic or other procedure" in very precisely measured and timed dosages under "operator or pre-programmed control" (col. 5, lines 54-57). As one of ordinary skill in the art would appreciate, when locating and anesthetizing nerve groups as taught in Raymond et al., the quantity of anesthetic administered is unimportant. What is important is administering the anesthetic in the correct location, i.e., near the target nerve group. It is also important to be able to selectively inject and aspirate the syringe, as aspiration will reveal if the tip of the syringe needle is improperly positioned (e.g., in a blood vessel, in which case blood would aspirate into the syringe to reveal the improper positioning of the needle). The Examiner asserts that it "it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Raymond et al. to include the use of a hands-free controller as per the teachings of Battiato et al., since it would provide a means of adequately providing a correct dosage of anesthetic to the located nerve during the procedure." 1/7/05 Office Action, p. 4. To the contrary, because one of ordinary skill in the art would know that anesthetizing a nerve group does not depend on such a "correct dosage," there is no motivation to combine the references as suggested by the Examiner. Moreover, Battiato et al.'s fluid injector is ill-suited for the injection/aspiration required to properly position a needle to anesthetize a nerve group, further demonstrating that one of ordinary skill in the art would not have been motivated to incorporate Battiato et al.'s fluid injector into Raymond et al.'s device for locating and anesthetizing nerve groups.

It appears that the Examiner is using impermissible hindsight to identify a motivation or suggestion to combine Battiato et al.'s syringe controller with Raymond et al.'s current generator. Specifically, Applicant submits that the Examiner is using Applicant's own disclosure of the combination of a hands-free syringe controller and a hands-free current generator to manufacture the motivation to reach such a combination. The prior art discloses no such motivation or suggestion. Accordingly, Applicant respectfully requests the withdrawal of the obviousness rejection of claims 1-3 and 14.

Applicant traverses the obviousness rejection of claim 3 for an additional reason. Claim 3 recites, among other things, that "the foot pedal is pivotally mounted to the base." The Examiner asserts that Battiato et al. discloses a syringe controller having a foot pedal that "is pivotally mounted to the base." 1/7/05 Office Action, pp. 3-4. However, Battiato et al. neither discloses nor suggests such a pivotally mounted foot pedal. The Examiner concedes that Raymond et al fails to disclose or suggest that "the foot pedal is pivotally mounted to the base." 1/7/05 Office Action, p. 3. Accordingly, Applicant respectfully requests the withdrawal of the obviousness rejection of claim 3.

Claims 15 and 25-27 were rejected under 35 U.S.C. § 103 as obvious over Raymond et al. in view of Battiato et al., and further in view of Attaway (GB 2322744 A). Applicant traverses this rejection because there is no motivation to combine Raymond et al. and Attaway as suggested by the Examiner. The purpose of the invention disclosed in Raymond et al. is to automatically control "[t]he amount of current generated by the electrical source ... so as to maintain the signal generated as a function of the response of the nerve to the stimuli" (col. 3, lines 28-32). Attaway discloses a foot-operated musical instrument volume control that is used to manually increase or decrease the volume of a musical instrument. The Examiner asserts that it would have been obvious to incorporate Attaway's foot-operated volume controller into Raymond et al.'s current generator to "provide a means to the physician to adjust the current to the device without using his/her hands during the procedure" (1/7/05 Office Action, p. 5). First, the musical instrument field is so unrelated to the field of locating and anesthetizing nerve groups that Attaway is non-analogous art, and cannot form the basis of a prima facie obviousness rejection. Second, Raymond et al. explicitly teaches away from the combination proposed by the Examiner. The current generator in Raymond et al. is specifically designed to automatically adjust the amperage output based on a sensed response to a stimulus. Replacing the automatic amperage controller in Raymond et al. with the manual controller disclosed in Attaway would

impermissibly defeat the purpose of the invention in Raymond et al. *See* MPEP § 2143.01 (“If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.”) (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). Accordingly, there is no motivation or suggestion to combine Raymond et al. and Attaway as suggested by the Examiner, and Applicant respectfully requests the withdrawal of the obviousness rejection of claims 15 and 25-27.

Even if there was a motivation or suggestion to combine Attaway with Raymond et al. as suggested by the Examiner, the combination would not render claim 15 obvious. Claim 15 recites, among other recitations, that “actuation of the first foot switch increases the amperage, and ... actuation of the second foot switch decreases the amperage.” The Examiner acknowledges that Raymond et al. and Battiato et al. fail to disclose this recitation (1/7/05 Office Action, p. 4). Attaway does not cure this deficiency. Attaway discloses a “volume control” that utilizes a “potentiometer” to vary the voltage of a signal, not an amperage as claimed in claim 15 (p. 3, line 1). Accordingly, none of the cited references nor their combination disclose or suggest the combination of recitations in claim 15. Applicant therefore respectfully requests the withdrawal of the obviousness rejection of claim 15, as well as its dependent claims 25-27, which are allowable at least because they depend from claim 15.

Claims 18-19 were rejected under 35 U.S.C. § 103 as being obvious over Raymond et al. in view of Battiato et al., and in further view of Hill et al. (U.S. Pat. No. 6,449,507). Claim 20 was rejected under 35 U.S.C. § 103 as being obvious over Raymond et al. in view of Battiato et al., and in further view of Eggers et al. (US 2003/0023285 A1). Applicant traverses these rejections at least because claims 18-20 each depend from patentable claim 1.

New claims 28-31 further distinguish the present invention from the cited prior art.

SHIMM -- 10/086,441  
Client/Matter: 078603-0283392

In view of these remarks and amendments, Applicant submits that the present invention is in condition for allowance, an early notification of which is earnestly solicited.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,

PILLSBURY WINTHROP SHAW PITTMAN LLP



BENJAMIN L. KIERSZ

Reg. No. 51875

Tel. No. 703 905.2114

Fax No. 703 905.2500

Date: July 7, 2005  
P.O. Box 10500  
McLean, VA 22102  
(703) 905-2000